



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/01/98	03/01/98	ZIMMERMAN	4-205247A

NM11/0605

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EXAMINER BERCH

ART UNIT 1624	PAPER NUMBER
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DATE MAILED: 06/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Communication Re: Appeal

Application No.

09/051,827

Applicant(s)

ZIMMERMANN ET AL.

Examiner

Mark L. Berch

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☐ The Notice of Appeal filed on _____ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 1.17(b).
- (c) ☐ the appeal fee received on _____ was not timely filed.
- (d) ☐ the submitted fee of \$_____ is insufficient. The appeal fee required by 37 CFR 1.17(b) is \$_____.
- (e) ☐ the appeal is not in compliance with 37 CFR 1.191 in that there is no record of a second or a final rejection in this application.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on _____.

2. ☒ The appeal brief filed on 14 May 2001 is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 1.192.
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 1.17(c).
- (c) ☐ the submitted brief fee of \$_____ is insufficient. The brief fee required by 37 CFR 1.17(c) is \$_____.

☒ *Wrong claims. see memo*

The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. Extensions of time may be obtained under 37 CFR 1.136(a).

3. ☐ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 1.17(c) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136 has expired.
- (c) ☐ Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on _____.
- (d) ☐ other:

4. ☐ Because of the dismissal of the appeal, this application:

- (a) ☐ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration of the submission and prosecution has been reopened pursuant to 37 CFR 1.114.

Mark L. Berch
Primary Examiner
Art Unit: 1624

Art Unit: 1624

DETAILED ACTION

The Brief is improper as it is based on the wrong set of claims. For reasons set forth in the Advisory Action , the amendment of 5/14/01 was not entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

May 30, 2001

Advisory Action

Application No.

09/051,827

Examiner

Mark L. Berch

Applicant(s)

ZIMMERMANN ET AL.

Art Unit

1624

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THE REPLY FILED 14 May 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 February 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See memo.

4. ☐ Applicant's reply has overcome the following rejection(s): Part of enablement issue. See memo.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: 15.
- Claim(s) objected to: _____.
- Claim(s) rejected: 2-4, 6, 14 and 16-19.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other:

Mark L. Berch
Primary Examiner
Art Unit: 1624

DETAILED ACTION

The amendment filed 5/14/01 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues (new matter) that would require further consideration and/or search. The amendment to page 2 would constitute new matter. Page 9 second paragraph refers to aromatic carbocyclic rings being substituted, but this proposed language is broader, covering both aromatic and non-aromatic. Thus, substituted non-aromatic carbocyclic were never provided for in the specification. It is noted that the e.g. aminocyclohexyl which was pointed to previously falls into that category. That is, the aminocyclohexyl is not a substituted aromatic carbocycle.

The examiner notes that the page 15 material does provide for substituted heterocycles. Accordingly, the enablement rejection is modified to read " ... does not reasonably provide enablement for substituted non-aromatic carbocyclic rings."

The traverse on the "thio" issue is unpersuasive. The term "thio" is a generic one, indicating the presence of sulfur in some form. As a substituent, it has no one single generally accepted meaning. There could be intended thioxo ($=S$) or mercapto ($-SH$). It can also denote replacement by S of some other atom (normally, oxygen or carbon) as in "thioalkoxy", where O is replaced by S. Perhaps some term which began with "thio", like thiophene was intended. Whatever choice is selected must be supported by the specification.

Applicants have pointed to page 29, first full paragraph, for support of their defining thio as mercapto. This is unpersuasive for the following reasons:

A. This cannot be understood to define "thio" because the term "thio" never appears on the page.

B. The paragraph in fact is a presentation of examples of what is meant by "etherified mercapto group". Specifically, it sets forth what the etherifying group can be in the phrase "etherified mercapto group", i.e., it could be etherified with optionally substituted aryl. That is irrelevant to the issue at hand because the claim language does not have an etherified anything. Thus, it is directed to a question unrelated to the actual or proposed claim language.

C. The context is entirely different. The paragraph is discussing a protected amino, viz. an amino protected with an "etherified mercapto group". The issue at hand is the definition of a substituent in the R_4 radical. These are unrelated.

In summary, the fact that the word "mercapto" does appear in the specification in an entirely unrelated circumstance, on a page where "thio" does not appear, does not lead one of ordinary skill in the art to believe that "thio" means mercapto.

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May 30, 2001